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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,916	11/13/2003	Upvan Narang	CMED.10092	7324
45473 7590 07/10/2007 HUTCHISON LAW GROUP PLLC PO BOX 31686 RALEIGH, NC 27612			EXAMINER SILVERMAN, ERIC E	
		ART UNIT 1615	PAPER NUMBER	
		MAIL DATE 07/10/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/705,916	NARANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric E. Silverman, PhD	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 April 2007.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-36 is/are pending in the application.

4a) Of the above claim(s) 1-24, 35 and 36 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 25-34 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>4-19-07</u>	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group II, claims 25 – 34 in reply filed on 4/20/2007 is acknowledged. Because applicant did not distinctly and specifically point out any supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Pursuant to the response, claims 1 – 36 are pending, claims 1 – 24, 35, and 36 are withdrawn from consideration as reading on non-elected inventions, and claims 25 – 34 are discussed on the merits in this action.

### ***Information Disclosure Statement***

Note that the references which were lined through as not considered and marked as "not received" on the information disclosure statement were not found either in this application or in either of the parent applications. Applicants' should submit copies of these references to the PTO and list them on a new information disclosure statement if Applicants would still like the Office to consider them.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 25 – 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25 and 76 – 102 of copending Application No. 11/119,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending claim 25 does not recite instant process steps, however, commensurate steps are recited in copending claim 1 (copending claim 25 being a product made by the process of copending claim 1). Copending claims 76 – 102 are product claims that do not recite instant process steps, but read on a product that has the same structure and composition of instant product by process claims, thus rendering instant claims obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 25 – 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 – 35 of U.S. Patent No. 6,637,967. Although the conflicting claims are not identical, they are not patentably distinct from each other because while copending claims do not recite instant process steps, the article of copending claims reads on a product with structure and composition

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commensurate with instant product by process claims, thus rendering instant claims obvious.

Claims 25 – 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 20 of U.S. Patent No. 5,928,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because while copending claims do not recite instant process steps, the articles of copending claims read on products with structure and composition commensurate with that of instant product by process claims. Also, instant claims do not require that the applicator be “pipette shaped” as in copending claim 1. Copending claims are thus a species of instant genus claims, rendering instant claims obvious in their entirety.

Claims 25 – 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 31 of U.S. Patent No. 6,595,940. Although the conflicting claims are not identical, they are not patentably distinct from each other because while copending claims do not recite instant process steps, the articles of copending claims read on products with structure and composition commensurate with that of instant product by process claims. Note that the “swab” of copending claims is commensurate with the “tip” of instant claims. Also, while copending applicator is required to be disposable, instantly claimed applicator need not be. As such, copending claims represent a species of instant genus claims, rendering the instant claims obvious in their entirety.

Claims 25 – 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 29 of U.S. Patent No. 6,779,657. Although the conflicting claims are not identical, they are not patentably distinct from each other because while copending claims do not recite instant process steps, the articles of copending claims read on products with structure and composition commensurate with that of instant product by process claims while copending claims do not recite instant process steps, the articles of copending claims read on products with structure and composition commensurate with that of instant product by process claims. Further, copending claims require the applicator to be “single use”, which is not required by instant claims. Thus copending claims are a species of instant genus claims, rendering the instant claims obvious in their entirety.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites “a polymerizable adhesive reservoir”. It is not clear if this refers to a reservoir made from polymerizable adhesive, a reservoir containing polymerizable adhesive, or something else. The artisan would thus be unable to determine the metes and bounds of this claim.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24 – 35 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/40797. Claims 24 – 35 are also rejected under 35 U.S.C. 102(a) as being anticipated by US 5,928,611 to Leung. Both references are already of record.

Note that the US Patent is a continuation of the WO document, and thus the two have the same disclosure. In the discussion below reference is made to the WO document with the understanding that the same teachings are also present in the US Patent.

Instant claim 25 is a product-by-process claim requiring an applicator comprising an applicator tip attached to an applicator body, wherein the tip is made by a method of mixing an active member with a precursor material, and then reacting the precursor to the form a structural material of the applicator tip with the active member dispersed in the finally produced applicator tip. This claim is examined with the understanding that prior art that has the same structure and composition as the product made by this method reads on the claim even though the prior art product may be made by a different method. Claim 26 requires that the applicator body comprise a conduit and that the tip be connected thereto so that fluid flowing through the conduit also flows through the tip. This is understood to be the conventional disposition of an applicator tip on an applicator designed for dispensing fluids, for example, a pipette tip on a pipette or similar. Claim 27 is similar to claim 26. Claim 28 requires that the applicator body have

no polymerizable adhesive reservoir, although the meaning of this term is unclear (*vide supra*). Claim 29 requires that the tip comprise a foam, and claim 30 requires that the applicator body be solid. Claim 31 requires that a polymerizable adhesive be contained separate from the applicator tip. Claims 32 – 34 further limit the nature of the polymerizable adhesive, with the ultimate species being either butyl or octyl alpha cyanoacrylate (also known as 2-butyl or 2-octyl cyanoacrylate).

The WO reference teaches an applicator tip made with a polymerization initiator dispersed therein (example). The applicator tip may be porous plastic (page 21) or foam (page 10). The applicator is also described as comprising a solid support (claim 21). An applicator is attached to the applicator tip so that a fluid flowing through the applicator also flows through the tip, and the applicator body is charged with a container containing a polymerizable monomer, which is in some embodiments 2-octyl cyanoacrylate (table 1). Although the applicator tip disclosed in the WO reference (and the US '611 patent) is not made by the method of instant product-by-process claims, it is not patentably distinct from instantly claimed product, and thus anticipates the instant claims.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric E. Silverman, PhD  
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MICHAEL P. WOODWARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600